



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

10,126

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on March 1, 2007

Signature

Typed or printed name

John C. McMahon

Application Number

10/650,910

Filed

August 28, 2003

First Named Inventor

Roger P. Jackson

Art Unit

3761

Examiner

Mary C. Hoffman

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 29,415☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

John C. McMahon

Typed or printed name

816- 531-3470

Telephone number

March 1, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
STATEMENT IN SUPPORT OF REQUEST OF REVIEW OF FINAL REJECTION

Applicant: Roger P. Jackson

Serial No.: 10/650,910

Filed: August 28, 2003



Date: March 1, 2007

Group Art Unit: 3761

Exam: Mary C. Hoffman

For: POLYAXIAL BONE SCREW WITH SPLIT RETAINER RING

- - - - -

Kansas City, Missouri

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following is in support of applicant's request of review of the final rejection of the above captioned application.

It is urged that the most recent Office action fails to base rejections on prior art that shows or describes all of the limitations of the claims. Reconsideration is therefore requested.

Claims 1 to 28 are rejected in various groupings as anticipated by Nichols (6,090,111), Barker (6,280,442), Morrison et al. (5,891,145) and Tatar (6,113,601).

Paragraph (d) of Claim 1 reads in part as follows with reference numerals added to help identify the parts in the drawings:

a retainer ring (7) non integral with said shank (2) and secured on said capture end of said shank so as to rotate with shank relative to said head (4) while in an adjustment configuration and being located within said head to provide a shank and retainer ring structure to retain said capture end within said head and enabling selective angular positioning of said shank with respect to said head, while in said adjustment configuration

Claim 1 therefore calls for a non integral retainer ring that is secured to and moves with the shank with respect to the head.

Nichols teaches a fastener or shank 14 with an enlarged integral upper portion, a retainer ring 42 and a head or securement body 16. However, the retainer ring in Nichols is fixed in position in the head and is not secured to nor does it rotate with the shank relative to the head. Consequently, Nichols does not anticipate Claim 1. It is noted the applicant's device offers significant advantages over Nichols including the fact that in Nichols there is only a single edge of the ring supporting the entire shank which can lead to failure, as opposed to substantial surfaces in contact between the retainer ring and

head in applicant's device. Consequently, while obviousness has not been raised, it is urged that applicant's invention is also not obvious in view of Nichols and provides benefits not suggested by Nichols.

The Barker patent provides essentially the same structure as Nichols. That is, a shank with an enlarged and partially spherically shaped integral top portion that is supported by a retainer ring that is fixed in position in the head and which is not secured to the shank and does not rotate with the shank.

The Morrison patent discloses a two part wedge structure which like in the two previous patents is fixed in position relative to the head. The wedges are not secured to the shank and do not articulate or move with the shank.

The Tatar patent discloses a device wherein the shank is downloaded through an aperture and has an enlarged top portion that is integral with the shank and upon which the shank rotates. A compression element or collet, such as 200a, is secured to the top of the shank by a ring 210. The collet and ring structure do not retain the shank within the head (this is accomplished by the integral enlarged upper portion of the shank) but rather acts to transfer compressive forces from the rod to the interface between the shank and the head.

Consequently, it is urged that all four of the cited references fail to make a prima facie showing of anticipation as

structure called for in Claim 1 is not found, taught or in any way suggested in these references.

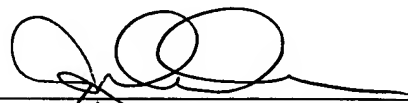
Independent Claim 13 (especially paragraph d) and Claim 22 (especially paragraph b) include structure similar to Claim 1 that distinguishes over the cited references for the same reasons as discussed above.

It is also noted that Claims 1, 13 and 22 have provisional and actual double patenting rejections entered with respect to them. While applicant does not concur that double patenting exists, it is an issue that is easily resolved by submission of a terminal disclaimer. Applicant agrees to submit such a disclaimer, but has not done so to date as certain of the rejections are provisional. It is suggested that the best time to make such a filing is when the application is otherwise allowable, so that the latest status of the other applications can be considered.

It is believed that with the filing of the disclaimer all pending claims distinguish over the current final rejection and the cited art of record and notice to that effect is requested.

Respectfully Submitted,

JCM:psp
PO Box 30069
Kansas City, Missouri
64112



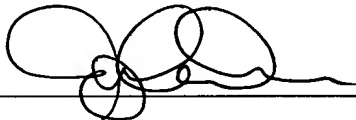
John C. McMahon
Reg. No. 29,415
Attorney

phone: (816) 531-3470

I hereby certify that this
correspondence is being deposited
with the United States Postal
Service as first class mail in an
envelope addressed to:
Mail Stop AF
Commissioner For Patents,
P.O. Box 1450,
Alexandria, VA 22313-1450 on
March 1, 2007.

Roger P. Jackson
(Applicant)

By

A handwritten signature in black ink, appearing to be 'R. Jackson', written over a horizontal line.

March 1, 2007

(Date of Signature)